

REMARKS/ARGUMENTS

Claims 1, 4 – 8, and 11 – 24 are presented for reconsideration and further examination in view of the foregoing amendments and following remarks.

In the outstanding Office Action, the Examiner rejected claims 1, 4 – 6, 8, 11 – 13, 16, 18 and 19 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,150,458 to Masuzaki (hereinafter referred to as “the Masuzaki ‘458 patent”); rejected claims 7, 14 and 20 under 35 U.S.C. §103(a) as being unpatentable over the Masuzaki ‘458 patent in view of Official Notice; and rejected claim 15 under 35 U.S.C. §103(a) as being unpatentable over the Masuzaki ‘458 patent in view of U.S. Patent No. 5,959,867 to Speciner (hereinafter referred to as “the Speciner ‘867 patent”).

By this Response and Amendment, claims 1 and 8 have been similarly amended to recite “prior to combining said plurality of desired original monochromatic images;” and claim 15 has been amended to recite “forming an original multicolor image file for output, outputted from a multicolor image output apparatus by combining a plurality of groups, *which were displayed prior to combining said plurality of groups*, at the display apparatus. As amended, the rejections to the independent claims and to the claims dependent thereon are traversed. It is respectfully submitted that the above amendments introduce no new matter to this application within the meaning of 35 U.S.C. §132.

Rejections Under 35 U.S.C. §102(b)

The Examiner rejected claims 1, 4 – 6, 8, 11 – 13, 16, 18 and 19 as being anticipated by the Masuzaki ‘458 patent.

Response

By this Response and Amendment, Applicant respectfully traverses the rejection since all of the features of the presently claimed invention are not disclosed, taught or suggested by the cited prior art. For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131.

Independent claim 1 recites "...the display section enables display of a plurality of groups prior to combining said plurality of desired original monochromatic images." Independent claim 8 recites "the control section allows the display section to display a plurality of groups prior to combining said plurality of desired original monochromatic images." And, independent claim 15 recites "forming an original multicolor image file for output, outputted from a multicolor image output apparatus by combining a plurality of groups, which were displayed prior to combining said plurality of groups, at the display apparatus."

The Masuzaki '458 patent discloses an electronic image information filing apparatus displaying editing corrections. An image input device 6 is an image scanner for scanning and converting an image to obtain two-dimensional, monochromatic image information. A CRT display controller 14 combines original image data 19 and editing data 20 so as to form resultant data. A CRT display controller 14 combines original image data 19 and editing data 20 so as to

form resultant data. A CRT display displays an image obtained by combining the monochromatic image information from the editing image memory 12, on a display screen in color. *See* column 3, line 20 to column 4, line 68.

In contrast to the presently claimed invention, the cited prior art does not disclose, teach or suggest that "...the display section enables display of a plurality of groups prior to combining said plurality of desired original monochromatic images" as recited in claim 1 or that "the control section allows the display section to display a plurality of groups prior to combining said plurality of desired original monochromatic images" as recited in claim 8, or "forming an original multicolor image file for output, outputted from a multicolor image output apparatus by combining a plurality of groups, which were displayed prior to combining said plurality of groups, at the display apparatus" as recited in claim 15. The Masuzaki '458 patent discloses an image that can be superimposed onto another image; however, the Masuzaki '458 patent does not disclose, teach or suggest a plurality of images that are intended to be displayed prior to superimposition onto each other. As such, the Masuzaki '458 patent does not anticipate the presently claimed invention. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection.

Rejections Under 35 U.S.C. §103(a)

The Examiner rejected claims 7, 14 and 20 as being unpatentable over the Masuzaki '458 patent in view of Official Notice; and, the Examiner rejected claim 15 as being unpatentable over the Masuzaki '458 patent in view of the Speciner '867 patent.

Response

By this Response and Amendment, Applicant respectfully traverses the Examiner's rejection since all of the features of the presently claimed invention are not disclosed, taught or suggested by the cited prior art combinations. To establish a *prima facie* case of obviousness, the Examiner must establish: (1) some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) the prior art references teach or suggest all of the claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

The arguments above with respect to the Masuzaki '458 patent are incorporated by reference. The Examiner does not take *Official Notice* to "...the display section enable[ing] display of a plurality of groups prior to combining said plurality of desired original monochromatic images" as recited in claim 1 or "the control section allow[ing] the display section to display a plurality of groups prior to combining said plurality of desired original monochromatic images" as recited in claim 8, or "forming an original multicolor image file for output, outputted from a multicolor image output apparatus by combining a plurality of groups, which were displayed prior to combining said plurality of groups, at the display apparatus" as recited in claim 15. Thus, the Masuzaki '458 patent in view of *Official Notice* has not been shown to support a *prima facie* case of obviousness.

Additionally, the Speciner '867 patent does cure the deficiencies of the Masuzaki '458 patent. The Speciner '867 patent discloses a computing system for processing page descriptions of documents including combinations of text, graphics and other images.

In contrast to the presently claimed invention, however, the cited prior art combinations do not disclose, teach or suggest that "...the display section enables display of a plurality of groups prior to combining said plurality of desired original monochromatic images" as recited in claim 1 or that "the control section allows the display section to display a plurality of groups prior to combining said plurality of desired original monochromatic images" as recited in claim 8, or "forming an original multicolor image file for output, outputted from a multicolor image output apparatus by combining a plurality of groups, which were displayed prior to combining said plurality of groups, at the display apparatus" as recited in claim 15. The Speciner et al. '867 patent is silent with respect to this feature. Thus, in view of the arguments above with respect to the Masuzaki '458 patent and *Official Notice*, and in view of the shortcomings of the cited prior art combinations as a whole, Applicant submits that the cited prior art combinations do not render the presently claimed invention obvious.

Accordingly, Applicant respectfully request that the Examiner reconsider and withdraw the rejections.

CONCLUSION

In light of the foregoing, Applicant submits that the application is in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicant respectfully requests that the Examiner call the undersigned.

In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

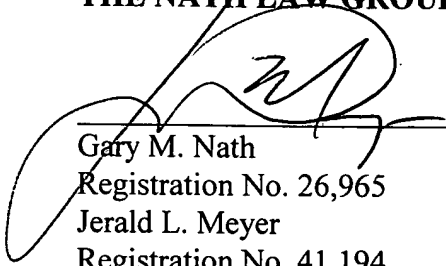
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Respectfully submitted,

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